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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,184	01/03/2006	Yoshitsugu Morita	71,051-003	7050

27305 7590 08/18/2010  
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EXAMINER
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WESTERBERG, NISSA M

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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08/18/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/526,184	<b>Applicant(s)</b> MORITA ET AL.	
	<b>Examiner</b> Nissa M. Westerberg	<b>Art Unit</b> 1618	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 112 - 1<sup>st</sup> new matter rejection.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,3-5,8-10 and 12-15.

Claim(s) withdrawn from consideration: 6,7 and 16-19.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

/Nissa M Westerberg/  
Examiner, Art Unit 1618

Continuation of 11. does NOT place the application in condition for allowance because: Claim 1, 3 - 5, 8 - 10 and 12 - 15 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed June 2, 2010 and those set forth below.

Applicant argues that chemical art is an unpredictable one with a certain level of unpredictability, especially in regard to a distribution of reaction products based on different condition. Attention is directed to example 4 and the Examiner was able to understand the claim clearly enough to issue additional rejections. These arguments are unpersuasive. It is unclear from the claim construction is the use of components (a) and (b) as the starting materials are sufficient to meet the limitation of linear organosilicon polymer of diorganosiloxane units and alkylene units as alkylene units can refer to both -CH<sub>2</sub>- in a saturated chain and unsaturated C=C bonds. While there is uncertainty in precisely defining reaction products, particularly for polymers, Applicants can clarify if using recited component (a) and (b) to form the component (A) in any manner is sufficient. Examples can serve to illustrate particular embodiments of the claims but are not limiting of claim scope. When there are multiple possible interpretations of a claim that renders the metes and bounds unclear, a rejection under 112, 2nd paragraph can be made. When art is found that reads on at least one of interpretation, art rejections are applied in order to further compact prosecution. Thus, the application of art rejections does not preclude the rejected claims from also being indefinite.

Claims 1, 3 - 5, 8 - 10 and 12 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (US 6,013,682) in view of Lochhead et al. (Cosmetics and Toiletries 1993) and Drake et al. (US 5,270,424). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed June 2, 2010 and those set forth below.

Applicant request clarification regarding Dalle et al. teaching component A when as acknowledged on p 6, the monomer of Dalle only used 2 carbons. The polymeric backbone of diorganosiloxane units and alkylene units is taught by Dalle. The Drake reference teaches the use of other dienes - 1,4-pentadiene and 1,5-hexadiene that provide the longer alkylene units provided by the diolefins of the Markush group (b) of claim 1 that will react to triple bonded SiH groups to produce siloxy terminated polydimethyl siloxane groups with additional carbon atoms as compared to the vinyl terminated siloxanes of Dalle.

The Dalle patent relies on organosilicon material to react with polysiloxanes but such organosilicon materials merely having vinyl groups are different from the diolefins claimed for the present invention. Dalle fails to teach or suggest the use of materials other than those that include silicon atoms within their own structure. The Examiner's reliance of the Drake patent in error to remedy this deficiency. While Drake teaches the reaction of silicon component with SiH grouped with dienes but focuses on chlorosilanes rather than diorganopolysiloxanes. Even if one skilled in the art would refer to the teachings of Drake, they would clearly choose chlorosilanes in combination with diene rather than the diorganopolysiloxanes with dienes as claimed. These arguments are unpersuasive. The diolefins are part of the starting materials used to prepare the actual polymer component. The same type of reactions are used in examples 1 - 3 of Dalle et al as are used in, for example practical example 1 of the instant specification, to prepare the diorganosiloxane and alkylene unit backbone polymer. The process described by Drake provides alternate monomer to the dimethylvinylsiloxy terminated polydimethyl siloxane that is used as the first ingredient in the examples of Dalle. All of the compounds of Drake contain at least a triple bonded-SiH group and the nature of additional substituents not critical (col 2, ln 40 - 47) and the presence of such substituents is not excluded by the instant claims which only require silicon-bonded hydrogen atoms at the two ends of the molecular chain. As set forth in the middle paragraph of p 7 of the previous Office Action, the inclusion of longer hydrocarbon units between the diorganosiloxane units alter the physical properties of the polymer backbone that is prepared.

Applicants also argue that the Examiner has not provided any articulated reasoning as to why one would make such a substitution in the manner described as to for what intended use and the desired properties. These arguments are unpersuasive. Three properties of the polymers were set forth including polymeric backbone flexibility, inter- and intramolecular interactions and hydrophobicity/hydrophilicity characteristics. These polymers are used in a wide variety of products and depending on the particular product being formulated and the other ingredients present, a single polymer will not meet the needs to formulate the wide variety of compositions and particular compositions within each type. The polymer backbones with alternative length -CH<sub>2</sub> linker segments will that required variability/

While Applicant notes that Lochhead does not remedy the deficiencies of the Dalle et al. and Drake et al. patents, no specific arguments in regard to this reference is presented.

Claims 1, 3 - 5, 8 - 10 and 12 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Lochhead and Drake as applied to claims 1, 3 - 5, 8 - 10 and 12 - 15 above, and further in view of Gee (US 4,602,878). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed June 2, 2010 and those set forth below.

While Applicant note that the '878 patent does not remedy the deficiencies of the Dalle et al. and Drake et al. patents, no specific arguments in regard to this reference is presented. Therefore this rejection is maintained for the reasons set forth above.